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PATENT
Attorney Docket No.: TJW-00100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit: 1723
Timothy J. Williams)	Examiner: Sorkin, D.
Serial No.: 09/579,938)	<u>TRANSMITTAL LETTER</u>
Filed: May 26, 2000)	162 N. Wolfe Road
For: MOUNTABLE REUSABLE PAINT)	Sunnyvale, CA 94086
CONTAINER WITH SPIGOT)	(408) 530-9700
ASSEMBLY AND STIRRING)	Customer No. 28960
MECHANISM)	

MS: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed please find a reply brief in response to examiner's answer for filing in the U.S. Patent and Trademark Office.

The Commissioner is hereby authorized to charge any additional fee or credit overpayment to our Deposit Account No. 08-1275. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: June 26, 2006

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CERTIFICATE OF MAILING (37 CFR § 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.

Date: 6/26/06 By: [Signature]



PATENT
Atty. Docket No.: TJW-00100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Timothy J. Williams

Serial No. 09/579,938

Filed: 05/26/00

For: **MOUNTABLE REUSABLE
PAINT CONTAINER WITH
SPIGOT ASSEMBLY AND
STIRRING MECHANISM**

Group Art Unit: 1723

Examiner: Sorkin, D

**REPLY BRIEF IN RESPONSE TO
EXAMINER'S ANSWER**

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed on May 1, 2006, this Reply Brief is hereby submitted to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.41. Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34 (including the independent Claims 1, 7, 11, 16, 22 and 34) have been rejected, Claims 2, 8, and 12 have been canceled and Claims 20 and 27 are allowed.

The Examiner has incorrectly rejected claims under 35 U.S.C. § 112, first paragraph. The Examiner has also incorrectly rejected claims where the prior art does not teach all of the limitations of the claims.

Appellants contend that the rejection of Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34 is in error and should be overcome by the appeal in the application referenced above. Appellants further contend that the DeVito, Briggs, Corbin, Reed and Moran patents, in addition to the "Cole Palmer's Food Tech Source," as applied, do not support the rejection of Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34. In view of the foregoing, Appellants respectfully submit this Reply Brief, wherein:

the **STATUS OF THE CLAIMS**, begins on page 2;
the **GROUND FOR REJECTION**, begin on page 3; and
ARGUMENTS, begin on page 4 of this paper.

STATUS OF THE CLAIMS

Claims 1, 3-7, 9-11 and 13-34 are pending in this case.

Claims 29-33 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1, 3, 4 and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,842,606 to DeVito (hereinafter "DeVito").

Claims 1, 3, 4 and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,109, 482 to Briggs (hereinafter "Briggs").

Claim 34 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,848,019 to Corbin et al. (hereinafter "Corbin").

Claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,311,017 to Reed et al. (hereinafter "Reed").

Claims 21 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reed in view of Briggs.

Within the Appeal Brief, Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34 are appealed.

GROUND OF REJECTION AND MATTERS TO BE REVIEWED ON APPEAL

The following issues were presented in the Appeal Brief for review by the Board of Patent Appeals and Interferences:

1. Whether the Claims 29-33 are properly rejected under 35 U.S.C. § 112, first paragraph;
2. Whether the Claims 1, 3, 4 and 29 are properly rejected under 35 U.S.C. § 102(b) as being anticipated by DeVito;
3. Whether the Claims 1, 3, 4 and 29 are properly rejected under 35 U.S.C. § 102(e) as being anticipated by Briggs;
4. Whether the Claim 34 is properly rejected under 35 U.S.C. § 102(b) as being anticipated by Corbin;
5. Whether the Claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Reed; and
6. Whether the Claims 21 and 28 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Reed in view of Briggs.

ARGUMENT

I. SUMMARY OF THE CLAIMED INVENTION

The invention disclosed in the present application number 09/579,938 is directed to a mountable reusable paint container that is configured for mounting on a wall and includes one or more separate storage compartments formed in a downward sloping configuration with each compartment having a spigot coupled at the base for dispensing the stored paint product. [Present Specification, page 2, lines 2-4] The paint container further includes molded air tight lids configured for fitting over each of the compartments. [Present Specification, page 2, lines 5-6] Each of the paint containers preferably have a stirring mechanism formed within the lid which extends into the paint container when the lid is positioned over the paint container. [Present Specification, page 2, lines 6-7] The stirring device extends downward into the reusable paint container and includes a top handle portion, a threaded distance rod and a bottom fin portion. [Present Specification, page 2, lines 8-9] The bottom fin portion includes a plurality of small evenly spaced fins formed of plastic which rotate with the stirring device in the paint container when the top handle portion is manually activated. [Present Specification, page 2, lines 9-11]

In one aspect of the present invention, a frame is configured for holding the paint storage compartments. [Present Specification, page 3, line 22] In another aspect of the present invention, a body is configured for holding the paint compartments. [Present Specification, page 4, line 7] Moreover, the present invention specifies a means for dispensing removably coupled to the paint storage compartments. [Present Specification, page 2, lines 18-19]

II. THE REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH, FOR FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT IS IMPROPER.

Appellants respectfully submit that the present specification is sufficiently descriptive with regards to a “size sufficient for paint to flow through.” As described previously, the present specification provides that “[t]he spigot body 114 includes an aperture 120 and an interior through which the paint flows.” [Present Specification, page 9, lines 26-27] It is clear from at least this quoted sentence that the dispensing mechanism inherently has a size sufficient for paint to flow through. Further explanation is not needed within the specification, as the size of the dispensing mechanism should be sufficiently clear to those skilled in the art.

III. GENERALLY THE REFERENCES APPLIED ARE DIRECTED TO NON-ANALOGOUS ART AND DO NOT CONTAIN EVERY LIMITATION OF THE CLAIMS

Appellants respectfully submit that the cited references are directed to non-analogous art. Although Twin Disc, Inc. v. U.S., 231 USPQ 417, 424 (Cl. Ct. 1986) and the MPEP § 2131.05 suggest that whether the reference is analogous art is not relevant to whether that reference anticipates, the reference is anticipatory only if it explicitly or implicitly discloses every limitation recited in the claims. This additional language in the MPEP which requires every limitation to be recited in the claims, highlights a reason why the references do not anticipate the present invention. Most of the references cited are directed to beverage containers. None of the cited references anticipate a paint storage container including a plurality of paint storage compartments and a dispensing mechanism removeably coupled to the base of the paint storage compartments. In re Schreiber, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997) is relied on by the Examiner to support the proposition that the claims may still be anticipated by a reference that does not discuss paint. The applicant respectfully disagrees and believes Emergency Fuel, LLC v. Pennzoil-Quaker State Co., 293 F. Supp. 2d 569, applies more aptly. The court in Emergency Fuel provides, “[t]he appropriate analogy is therefore MEHL/Biophile, not Schreiber: new methods may be patentable even if they employ old tools.” The present claims cannot be anticipated by references directed to beverage containers which do not include a plurality of paint storage compartments and a dispensing mechanism removeably coupled to the base of the paint storage compartments, since the storage compartments and dispensing mechanism for paint are inherently different than those of beverage containers. The Examiner argues within the Examiner’s Answer that “‘paint’ is not an element of the claimed structure for any of claims 1, 3, 4 and 29.” [Examiner’s Answer, page 15] However, “paint storage compartments each for storing paint” is clearly within claim 1. The Examiner has also argued that, “appellant’s assertion that ‘paint will not flow through just any size opening’ is not supported by evidence or reasoning.” [Examiner’s answer, page 16] However, it is appellant’s position that under typical conditions, including typical pressure conditions, with the size and structural restraints of the present invention, a hole that is sized for milk or some other beverage is able to be much smaller than that required for a paint dispensing mechanism. Thus, prior art not related to paint dispensing has been improperly utilized. Furthermore, the prior art does not include all of the limitations of the claims within the present application.

Within the Examiner’s Answer, the Examiner still gives no significance to the phrases, “paint storage compartments,” “storing paint” and “dispensing paint.” However, as discussed

previously, In re Schreiber, 44 USPQ 2d 1429, 1478 (Fed. Cir. 1997), provides “[a] patent applicant is free to recite features of an apparatus either structurally or functionally.” The present invention includes both structural and functional features including “paint storage compartments,” “storing paint,” and “dispensing paint.” The claims do not merely discuss paint, but are specifically directed to a paint storage container. This is more than an intended operation, but specifically defines the type of apparatus that is claimed. The prior art does not teach or make obvious a paint storage container.

Additionally, in reference to the Devito, Briggs and Reed prior art, it is provided in Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532 (Fed. Cir. 1987), that, “a court can not ignore a plethora of meaningful limitations.” Moreover, Diversitech Corp v. Century Steps, Inc., 850 F.2d 675, 677-78 (Fed. Cir. 1988), provides, “limitations stated in the preamble limit the claimed invention.” The present invention specifically claims a “paint container” in the preamble and further includes “paint storage compartments,” “storing paint,” and “dispensing paint” throughout the body of the claims. All of these limitations must be included and cannot be ignored. Therefore, references directed to beverage dispensers do not anticipate the presently claimed paint container device.

Appellant reaffirms that as known to those skilled in the art, paint has a certain consistency and viscosity and will not flow through just any size opening. In particular, paint requires a larger opening than a beverage. As described above, paint, specifically house paint, is typically between 3,000-6,000 centipoise and sometimes upwards of 20,000 centipoise, hence it is obvious that its viscosity will not permit it to flow through a small opening that liquids like soda could flow through. [See the attached articles <http://www.currys.com/knowledge/aboutairbr.html>; and http://66.102.7.104/search?q=cache:z1AWOHkFI_sJ:building-repair-materials.home-items-porta1.com/1-US-Gallon-Endure-Permanent-Exterior-House-Paint-3535666.html+%22house+paint%22+centipoise&hl=en].

IV. THE CITED REFERENCES DO NOT DISCLOSE, TEACH, OR EVEN SUGGEST EACH AND EVERY ELEMENT OF THE CLAIMS

A. DeVito

DeVito, simply does not disclose, teach, or even suggest a means for dispensing removeably coupled to the base of the paint storage compartments for dispensing paint from the paint storage compartments. Devito teaches a beverage server. [Devito, Title] Devito explicitly teaches that his invention relates generally to drink serving devices, and, more specifically, to a

beverage server able to provide a user with a desired number of drink selections. [Devito, col. 2, lines 10-12] Devito does not teach a paint storage container for storing and dispensing paint. Devito also does not make obvious a paint storage container for storing and dispensing paint. As described previously, the issues and concerns with storing and dispensing paint are very different than storing and dispensing beverages.

B. Briggs

Briggs, simply does not disclose, teach, or even suggest a means for dispensing removeably coupled to the base of the paint storage compartments for dispensing paint from the paint storage compartments. Briggs teaches a device for dispensing liquid from a bottle. [Briggs, Title] Briggs explicitly teaches that the general purpose of his invention is to provide a soda dispenser for conveniently dispensing soda from a 2-liter bottle or the like. [Briggs, col. 1, lines 30-35] Briggs does not teach a paint storage container for storing and dispensing paint. Briggs also does not make obvious a paint storage container for storing and dispensing paint. As described previously, the issues and concerns with storing and dispensing paint are very different than storing and dispensing soda in 2-liter bottles.

C. Corbin

Corbin, simply does not disclose, teach, or even suggest a plurality of paint storage compartments each for storing a color paint, each paint storage compartment having a front, a back, a first side, a second side and a base. Corbin teaches a device for mixing paints. Corbin does not teach a paint storage container for storing paints in an organized manner which will be used at a later date. Corbin teaches that the paint enters temporary storage reservoirs, is mixed, and is then output into a container.

D. Reed

Reed, simply does not disclose, teach, or even suggest a means for dispensing removeably coupled to the base of the paint storage compartments for dispensing paint from the paint storage compartments. Reed teaches a thermoelectric jug cooler for changing the temperature of a quantity of liquid. [Reed, col 2, lines 19-22] Reed does not teach a paint storage container for storing and dispensing paint. Reed also does not make obvious a paint storage container for storing and dispensing paint. As described previously, the issues and concerns with storing and dispensing paint are very different than changing the temperature of a quantity of liquid.

Furthermore, it is stated within the Examiner's Answer, that the Examiner acknowledges Reed does not explicitly state that the dispensing means is removable. The Examiner also argues that Appellant did not address why making this part removable would not have been obvious to one of ordinary skill in the art at the time of the invention. [Examiner's answer, page 22] The

dispensing means is removable to allow easier cleaning after use of the present invention. Generally, paint storage devices are difficult to clean because of the inherent properties of paint, and when the device comes in one piece, it makes the cleaning process even harder. By making components of the device detachable, which is not an obvious modification, the process of cleaning becomes much easier.

V. CONCLUSION

Each of the claims pending within this appeal include limitations specifying that the device is directed to a paint container. There is nothing in the teachings of the cited references that support the rejections of claims with such limitations. To support the rejection of the pending claims, the Examiner has ignored much of the claim language. As discussed in detail above, by ignoring the limitations provided, the Examiner is impermissibly modifying the claims. In view of the foregoing, it is respectfully submitted that Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34 (including the independent claims 1, 7, 11, 16, 22 and 34) are allowable over the teachings of the cited references. Therefore, review of this appeal and a favorable indication is respectfully requested.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: June 26, 2006

By: Jonathan O. Owens
Jonathan O. Owens
Reg. No. 37,902
Attorneys for Applicants

CERTIFICATE OF MAILING (37 CFR § 1.8(a))

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HAVERSTOCK & OWENS LLP

Date: 6/26/06 By: [Signature]